REMARKS

Applicants have considered the outstanding official action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

It is noted that the withdrawn non-elected process claims have been amended to correspond to the amendments in the elected product claims in the event of rejoinder of the process claims upon allowance of the product claims.

Initially, the Examiner has stated that claims 125-126 as added in the Amendment filed June 26, 2009 include claim limitations that differ from the limitations of elected claim 63 to an extent requiring restriction between claims 125-126 and claim 63. Applicants respectfully disagree since claims 125- 126 are directed to a multi-ply web material as elected. This is apparent from the overlap in claimed subject matter between elected claims 63-85 and subsequently added claims 125-126. Each of these claims have in common that they are directed to a multi-ply web material comprising at least three plies joined to one another by adhesive. The three plies claimed in each of claims 63-85 and claims 125-126 include the same claimed

first ply with first pattern composed of first decorative elements formed of at least one inward projecting protuberance and having a density of no more than 3 elements/cm^2; the same claimed second ply with second pattern composed of second decorative elements formed of at least one inward projecting protuberance and having a density of no more than three elements/cm^2, and the same third ply therebetween. Additional limitations contained in claims 125 and 126 are to further define the web material and would be similar to where limitations are added into dependent claim 63 to further define the web material claimed. Claims 125 and 126 were added to consolidate prosecution by adding, in view of the Examiner's first office action, alternative manners of claiming the elected invention. The Manual of Patent Examining Procedure (MPEP) §803 provides that the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP §802.01, §806.06, and §808.01) or distinct (MPEP §806.05 - §806.05(j)). Further, if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include

claims to independent or distinct inventions. Id. MPEP §803 provides two criteria for a proper requirement for restriction between patentably distinct inventions: (A) the inventions must be independent (see MPEP §802.01, §806.06, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(j)); and (B) there would be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §808, and §808.02). Id. Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP §806.05(c) - §806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. See MPEP §808.2. Thus, the examiner must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search. Id. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions. Id.

Applicants respectfully submit that the Examiner has not established that the multi-ply web material claimed in claims 125-126 meets the requirements for restriction as set forth above. Particularly, the examiner has not shown that the multi-ply web material of claims 125-126 are independent or distinct from the multi-ply web material of claims 63-85. Further, the Examiner has not shown a serious burden on him if restriction of these claims is not required. Rather, claims 63-85 and 125-126 are all drawn to a multi-ply web material with significant overlapping claim limitations drawn to structural features required in each claimed web material. Thus, removal of the withdrawn status of claims 125-126 and consideration on the merits of claims 125-126 are requested.

Claims 63-85 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement as set forth at pages 4-7 of the official action.

As to claim 63, the Examiner objects to the language "that decorative elements of one pattern do not damage decorative elements of another pattern" as not being supported by applicants' specification. Applicants disagree with the Examiner in that the referred to language of claim

63 relates to the pattern of one ply not being in phase with the pattern of the other ply. The two patterns of plies V1 and V2 are staggered so that the two patterns are mutually positioned so as to not interfere with one another. However, in order to move prosecution forward, claim 63 has been amended to clarify this feature. Claim 63 has been amended to state that "the decorative elements of one of the first ply or the second ply are intercalated between the decorative elements of the other of the first ply or the second ply". Support is present in the specification at page 12, lines 1-3; and Figures 3 and 7.

Further as to claim 63, the Examiner states that the language "areas in said second ply corresponding to said areas in the first ply are devoid of any protuberance or flattened protuberance" is not supported by applicants' specification. Applicants have amended claim 63 to claim that "areas in said second ply corresponding to said areas in the first ply are devoid of any protuberance or <u>have a</u> flattened protuberance". Support is present in the specification at page 5, lines 5-11; page 10, lines 4-5; page 11, lines 9-13; Figures 3 and 7.

Further as to claim 63, the Examiner states that the language "the first ply and the second ply are adhesive-

bonded to one another at least at said areas where said first adhesive is applied" is not supported by the specification since there is no support for the first and second plies to be adhesive-bonded, or glue-bonded, to each other, only that each ply is glued to a third interposing ply. Applicants respectfully disagree. For example, as claimed in dependent claim 65, a first adhesive can seep at least partly between the third ply and the first ply to reciprocally glue the third ply to the first ply and the third ply to the second ply. Thus, adhesive does serve to adhere the first ply to the second ply. However, to clarify the language, claim 63 has been amended to provide that the first ply and the second ply are adhesively-bonded together.

As to claim 69, the Examiner states that the limitation "protuberances having a height..." is not supported by the specification because the MPEP equates "having" with the open language of "comprising". Applicants disagree since "having" is not used as a transition term in the present context. However, in order to advance prosecution, applicants have amended the term "having" to "of". Support is present in the specification at page 4, line 34 to page 5, line 2.

Accordingly, applicants submit that the claims comply with the written description requirement of 35 U.S.C. §112, first paragraph. Withdrawal of the §112 rejection is requested.

Claims 63-85 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite as set forth at pages 7-8 of the official action.

As to claim 63, the Examiner states that claim 63 is indefinite as reciting two contrary limitations: (1) "a third ply is interposed between said first ply and said second ply" and (2) "the first ply and the second ply are adhesive-bonded to one another". Applicants respectfully disagree. However, as set forth above, limitation (2) above of claim 63 has been amended to claim that "the first ply and the second ply are adhesive bonded together ...". Support is present in the specification at page 4, lines 19-29 and; page 13, lines 4-11. A first glue is applied to the third ply in areas corresponding to the protuberances forming the first decorative elements. The glue seeps at least partly between the third ply and the first ply to reciprocally glue the third ply to the first ply and to glue the third ply to the second ply. Thus, glue crosses the central ply V3 to adhere the first ply V1 to the second ply

V2 with the third ply V3 interposed therebetween. Further, glue may be applied between plies V1 and V3 and between plies V2 and V3 to adhere the plies together. See page 4, lines 24-29. Accordingly, the first ply and the second ply are adhered together with the third ply interposed therebetween. See Figures 3 and 7.

As to claim 85, claim 85 has been amended to clarify the antecedent basis for "the first outer surface" and to clarify the position of the axis.

Accordingly, applicants submit that the claims are definite within the meaning of 35 U.S.C. §112, second paragraph. Withdrawal of the §112 rejection is requested.

The outstanding rejections based on art are as follows:

(1) Claims 63-68, 76, 79-82 and 84-85 under 35 U.S.C. §102(b) over U.S. Patent No. 6,599,614 B1 (Roussel);

(2) Claims 69-74 under 35 U.S.C. §103(a) over Roussel in view of U.S. Patent No. 6,106,928 (Laurent) and in further view of U.S. Patent No. 6,755,928 B1 (Biagiotti);

(3) Claim 75 under 35 U.S.C. §103(a) over Roussel in view of U.S. Patent Application Publication No. 2005/0034828 A1 (Graff);

(4) Claims 77-78 under 35 U.S.C. §103(a) over Roussel in view of U.S. Patent No. 6,221,211 B1 (Hollenberg); and

(5) Claim 83 under 35 U.S.C. §103(a) over Roussel in view of Biagiotti.

Claim 63 is the sole rejected independent claim in the absence of consideration of added claims 125-126 as discussed above. Roussel is the only reference applied under the §102 rejection and is the primary reference as to each of the rejections under 35 U.S.C. §103 of dependent claims. Applicants respectfully submit that Roussel does not teach or suggest applicants' claimed web material.

Applicants' claimed web material provides a double-faced product, which has one decorative pattern on one face and a different decorative pattern on the other face. This is achieved by having first decorative elements of one ply arranged between second decorative elements of another ply. This requires a low density pattern and a particular arrangement of the low density pattern with respect to each other.

Roussel discloses a multi-ply product in which the plies are bonded tip-to-tip. With tip-to-tip arranged protuberances, adhesion between the plies is obtained at positions A1 and A2 where protrusions of the two outer plies are mutually coincident and glue is applied on the intermediate ply. See column 4, lines 4-15. This is different from applicants' claimed web material where decorative elements on a first ply are intercalated with decorative elements on a second ply. Further, adhesive C1 is arranged between at least some of the protuberances P1 forming the decorative elements on the first ply V1 and areas intercalated between protuberances P3 forming the decorative elements on the second ply V2. Roussel does not teach the claimed arrangement.

In the second to last paragraph of claim 63, the decorative elements are distributed with respect to each other so that the decorative elements of the first ply are intercalated between the decorative elements of the second ply. Thus, the decorative elements are staggered or out of phase with each other when the plies are joined. Roussel, however, teaches tip-to-tip arrangement of the protrusions in the first ply and the second ply such that gluing is obtained by pressing the protrusions of one ply against the

protrusions of the other ply. Thus, adhesion between the plies occurs at positions A1 and A2 where the protrusion of the two outer plies are mutually coincident and glue is applied on an intermediate ply. See column 4, lines 4-15. Thus, as shown in Figure 1 of Roussel, glue is applied in the position where protrusions 33 and 11 of plies 2 and 3 face each other. This requires that the protrusions on the plies 2 and 3 are not intercalated with respect to one another, but rather that the protrusions correspond to one another, i.e., are in phase one with each other.

Accordingly, Roussel does not teach first decorative elements and second decorative elements which are different from each other and are distributed with respect to each other so that the decorative elements of the first ply are intercalated between the decorative elements of the second ply as claimed.

Further, the claimed web material claims a first pattern composed of first decorative elements which include at least one protuberance projecting inward, and a second pattern composed of second decorative elements which include at least one protuberance projecting inward wherein each of the first and second decorative elements has a density of no more than 3 elements/cm^2. Roussel to the contrary teaches

at column 3, lines 3-13, that the product includes at least three plies wherein two are external embossed plies including patterns having at least in part discrete protrusions pointing inward, and at least one of the external plies has a "pattern density" exceeding 30 protrusions/cm^2. Accordingly, Roussel teaches a high density pattern and does not teach first and second patterns having respectively first decorative elements and second decorative elements wherein each has a density of no more than 3 elements/cm^2 as claimed. Accordingly, based on Roussel's teaching of the "pattern density" as exceeding 30 protrusions/cm^2, such protrusions are analogous to the decorative elements of which the pattern is composed in the claimed web material.

The high density of the protrusions in Roussel is a critical element therein since Roussel teaches high density of protrusions to achieve increased strength and crush resistance, see column 6, lines 40-42 which states –

> "It follows that the web of the invention is highly crush-resistant relative to a standard web of the point-to-point type. This strength increases as the protrusion density rises."

This is contrary to applicants' claimed web material which is of low density, i.e., decorative elements of the pattern having a density of no more than 3 elements/cm^2, and having first and second decorative elements on first and second plies, respectively, which are intercalated as to each other.

Therefore, Roussel clearly does not teach each and every feature of the claimed web material as set forth above and, thus, does not anticipate the claims within the meaning of 35 U.S.C. §102. Withdrawal of the §102 rejection is requested.

Further, with respect to the rejections of dependent claims under 35 U.S.C. §103 of which Roussel is the primary applied rejection, Roussel does not suggest the claimed web material as evident from the opposite effects taught. Contrary to Roussel, as set forth above, applicants' claimed web material is based on first and second patterns which are composed of first and second elements present in low density and intercalated as to each other. Roussel to the contrary is directed to a pattern of protrusions in high density which are joined together tip-to-tip. Thus, the structure described in Roussel and that claimed by applicants are distinct. Roussel does not

provide any suggestion to modify so as to achieve a structure not having these features which are utilized to achieve crush-resistance in the web.

As to the secondary references applied in combination with Roussel as to the dependent claims (i.e., Laurent, Biagiotti, Graff and Hollenberg), each are relied on for teaching further limitations of the dependent claims. Without acquiescing to the Examiner's assertions, applicants submit that, regardless, the secondary references do not make up for the shortcomings of Roussel as set forth above. For example, Laurent requires at least one pattern to include protrusions at a rate of "at least 30/cm^2" (see column 3, lines 25-41); Biagiotti teaches rollers having points in a density of 10 to 100 points/cm^2 (see column 8, lines 42-45); Graff teaches first and second zones wherein the second zone includes protrusions present in a density which "exceeds 30 protrusions/cm^2" (see page 1, paragraph 0017); and Hollenberg does not disclose patterns based on protrusions of a particular density, but rather teaches tissue having two or more plies containing colored or patterned indica (see column 1, lines 40-43). Accordingly, none of the secondary references teach any criticality as to pattern density and to the extent density is disclosed high

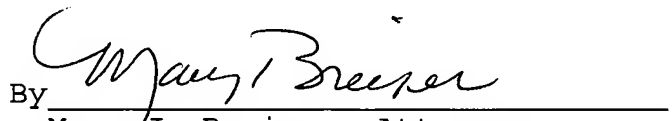
density as to protrusions is taught. The low density of the elements of which the pattern is composed is a critical aspect of applicants' claimed web material.

Applicants, therefore, respectfully submit that Roussel neither alone nor in combination with the secondary references, teaches or suggests applicants' claimed web material within the meanings of 35 U.S.C. §102 and §103, respectively. The secondary references, which are applied as to further limitations present in dependent claims, do not provide for the shortcomings of Roussel. Withdrawal of the §102 and §103 rejections is, therefore, requested.

Reconsideration and allowance of the claims are respectfully urged.

Respectfully submitted,

GIOVANNI NENCIONI ET AL.

By 

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